

Notice of Allowability

Application No.

09/417,266

Applicant(s)

MAROPIS ET AL.

Examiner

Art Unit

Roland G. Foster

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment and declaration, filed on 11/15/2004.
2. ☒ The allowed claim(s) is/are 1-17 (were 16 and 18-33).
3. ☒ The drawings filed on 12 June 2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 6/12/03 & 11/15/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

Affidavit or Declaration Under 37 CFR 1.131: Effective To Overcome Reference

The Declaration filed on November 15, 2004 under 37 CFR 1.131 is sufficient to overcome the Hazam reference (White Paper on Prepaid Local Phone Services Present by the National ALEC Association by Hazam, dated August 1999). The declaration provides sufficient evidence of conception of the claimed subject matter prior to the date of the teachings relied upon in the Hazam reference (August 1999) and diligence during the critical period just prior to the effective date of the reference (July 13, 1999) and ending with the date of constructive reduction to practice (October 12, 1999) (see the Affidavit of Kent E. Genin).

Allowable Subject Matter

Claims 16 and 18-33 are allowed.

Examiner's Reasons For Allowance

Regarding claims 16, 18 and 19, see pages 12 and 13 of the Non-final rejection, mailed on April 23, 2004 as Paper No. 32, for further reasons regarding the examiner's reasons for allowance.

Independent claims 20, 27, and 33 are substantially similar to the originally presented independent claims 1 and 8 previously prosecuted but cancelled by the amendment, filed on

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October 25, 2004. Therefore, independent claims 20, 27, and 33 would have been prosecuted in the same manner that claims 1 and 8 were prosecuted.

At the time of this amendment, independent claims 1 and 8 stood rejected under the combination of Hazam in view of U.S. Patent Application Publication No. 2002/0026418 A1 ("Koppel") (see the Non-final rejection, mailed on April 23, 2004 as Paper No. 32).

Hazam was the closest prior art of record for claims 1 and 8 but as discussed above, the declaration was sufficient to overcome the teachings relied upon in Hazam. Since the examiner has admitted that Koppel would have been obvious over the teachings of Hazam, the applicant's declaration was also sufficient to overcome Koppel.

Because the closet prior art of record Hazam is no longer available, the examiner falls back to the next closest prior art of record, which was identified and applied in the prior prosecution history of the case. Specifically, see the Notice of Allowance, mailed on March 10, 2003 for further details regarding the examiner's reasons for allowance of now cancelled claims 1 and 8 (and therefore applying to newly presented independent claims 20, 27, and 33) in view of other, applied prior art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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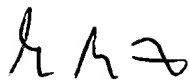
fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9309.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.


Roland G. Foster
Primary Patent Examiner
December 11, 2004
